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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,160	06/21/2001	John Otto Piepenbrink	END920010038US1	5994
23550	7590	12/15/2006	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC			BROOKS, MATTHEW L	
75 STATE STREET			ART UNIT	
14TH FLOOR			PAPER NUMBER	
ALBANY, NY 12207			3629	

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/886,160	PIEPENBRINK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew L. Brooks	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112 1<sup>st</sup>*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There exist many problems with enablement that would require examiner or one attempting to practice invention do conduct undue experimentation in order to practice use of said application/invention. The below are examples of components/limitations that are not enabled by the specification that can be applied to all of the claims where found.
3. As to "providing venture information" Applicant has stated the term with no definite scope as to include anything. Venture information submitted by one user may not be included in information submitted by another user. In fact there are limitless possibilities as to "venture information" could be. And for this reason alone Examiner would have to conduct undue experimentation to figure out what information is collected/ or is desired by user collecting said information. Making the user of the software the actual inventor. Just as a person using an Excel spread sheet to conduct Applicants recording of data into rows and columns would be an inventor per se.

4. As to "providing scoring data" there is no teaching of how to arrive at scoring data on the limitless possibilities of venture information that could be entered. For instance how would one "provide scoring data" on a business plan as found in claim 10? This would be left up to the subjective mind of the person considering joining the Venture. For examiner to figure out how to provide a scoring data to all of the venture information possibilities would require undue experimentation.

5. Also as to the analyzing a relationship and deploying one if positively evaluated. There is no framework and or teaching as to how or when to make the determination and employ the business relationship. And what a positive evaluation is and how determined and to do so would required undue experimentation.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup>***

6. Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. With respect to claim 1 for instance Applicant states in the preamble that this is a new method for "managing a relationship with a venture company" yet this invention is not for managing a relationship because as stated in the last lines of claim 1 it is an entity that is seeking a relationship, thus no relationship has yet been formed so it would be impossible to manage it. The preamble should likely read a method for analyzing whether to enter into a relationship with a venture company. (see claim 7)

8. Also with respect to claim 5 for instance Applicant states "...duplicating the single record from a first column of the queried row to a second column of the queried row..."

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When Examiner turns to Fig 9, it appears that Applicant really is "...duplicating the single record from a previous column of the queried row to a later column of the queried row..." If the first column were moved to the currently queried row for Venture company A for instance then the May query would read INITIAL. Appropriate action is required.

### ***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-16** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in the test of:

whether the invention produces a useful, concrete, and tangible result.

The present invention fails the "useful, concrete, tangible" result test. For an invention to be "useful" it must satisfy the utility requirement of section 101. The PTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP 2107. The claim must be for a practical application that produces a useful result and the Applicant should specifically recite in the claim the practical application. A claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application. In other words, if the specification discloses a practical application of an abstract idea, but the claim is broader than the disclosure such that it recites an abstraction, then the claim must be rejected. In the present case Applicant

mentions in the specification that the Venture Information is "information pertaining to a venture company (eg business plan, customers, predicated sales etc". Obviously "venture information" as used in the claim can be read so broadly as to include statutory subject matter and non.

Furthermore even if Applicant were to chose entering in a business plan there is no teaching as to how to provide a score or a number. IF this is done by a human, it would not be subject matter for patent and too subjective and not be concrete or substantially repeatable. Hence it would fail the concreteness requirement of section 101 because it is still unpredictable in that it is left in the hands of an arbiter to subjectively decide. The present invention lacks concreteness. Usually concreteness arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, because the invention cannot operate as intended without undue experimentation. See *infra*. In this regard Examiner turns to the Specification to make

out how the "evaluating the opportunity to enter into a relationship is determined and finds little or no guidance as to how this is determined. No enabling disclosure is present. For example To determine this would be to invent the invention due to all of the possible outcomes that could be expected and the many hours of undue experimentation to determine the results and even still another person skilled in the art may come to a completely decision as to what score to provide and whether or not to enter into venture, hence the invention lacks concreteness and is not enabled.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0032599 A1 (Chandler) in further view of US 2001/0023477 A1 (Jarske). Note:

due to the numerosity of claims and the repetitiveness thereof the most comprehensive claim 9 was examined for purposes of this action and its dependents up to 13.

Claim 9 is rejected under 35 U.S.C. 103 as being unpatentable over the Chandler in view of Jarske. The Chandler reference discloses all of the informational features normally provided by a venture company (Figs 15 and 30-33). Further Chandler discloses that the questionnaire/information provided automatically populates a pre-scripted narrative form that is available to download or access electronically that may also be subject to a rating system which in turn can be used to evaluate potential investment/venture opportunities [0013]. Chandler does not discuss the type of database used and or how the data stored in it is searched or queried in the manner claimed by Applicants.

However Jarske teaches copying first memory rows into second memory rows which is achieved with parallel memory updating, by copying a row from the first memory to a row in the second memory. The rows in the first memory are old (not updated) and the rows formed in the second memory are new (updated). [0012] Jarske also teaches that this method of updating is faster and eliminates trace back. [0008] Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the row/column updating method taught by Jarske to store and access the data in one's database in a typical venture evaluation system such as that taught in Chandler for the purpose of obtaining account information. The desirability to do this is clearly to save a time and eliminate trace back while providing the most up to date information at the time of query.



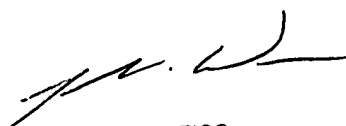
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLB  
12/06/06



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